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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,863	08/04/2003	Yoshifumi Tanimoto	030817	4619
38834 7590 07/23/2007 WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036			EXAMINER BIAGINI, CHRISTOPHER D	
			ART UNIT 2142	PAPER NUMBER
			MAIL DATE 07/23/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/632,863

Applicant(s)

TANIMOTO, YOSHIFUMI

Examiner

Christopher D. Biagini

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-16 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-16, and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed May 30, 2007 regarding the rejection under 35 USC 112, second paragraph have been fully considered but they are not persuasive.

2. MPEP 2181, section II states,

The disclosure of the structure (or material or acts) may be implicit or inherent in the specification if it would have been clear to those skilled in the art what structure (or material or acts) corresponds to the means (or step)-plus-function claim limitation. See *Id.* at 1380, 53 USPQ2d at 1229; *In re Dossett*, 115 F.3d 942, 946-47, 42 USPQ2d 1881, 1885 (Fed. Cir. 1997). **If there is no disclosure of structure, material or acts for performing the recited function, the claim fails to satisfy the requirements of 35 U.S.C. 112, second paragraph.** [Emphasis added.]

3. The Examiner recognizes the disclosure of the "storage unit" which corresponds to the claimed "means for storing" and the "mail client" which corresponds to the claimed "means for forming", but respectfully maintains that the disclosure related to the "means for transmitting" is insufficient to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Applicant points to the word "transmitter" as describing a structure corresponding to the claimed "means for transmitting," but the Examiner respectfully disagrees with this assertion. According to the Examiner's reading of the specification, the "transmitter" is in fact a human operator, rather than a structural component. Page 5, lines 6-11 describes the exchange of email between two mail clients, "mail client 2 of a transmitter and mail client 18 of a recipient." Although in some contexts a "transmitter" is an electronic device, its analogue in these contexts is not a "recipient," but a "receiver." In

other words, the use of the term "recipient" implies that the transmitter and recipient are *one who transmits* and *one who receives*, respectively. Additionally, the structure of the quoted sentence does not support the interpretation that the transmitter and recipient are components of their respective mail clients. Finally, the specification describes transmitters as having a "level of authority," a quality normally associated with human operators (see p. 7, lines 18-22). Indeed, this interpretation appears to be consistent with the claims as originally filed, which refer separately to a "means for transmitting" (original claim 1) and a "transmitter" (original claims 9-12). It is unclear why the distinction was made in the original claims if "means for transmitting" and "transmitter" are intended to refer to the same structure.

5. Due to the lack of clarity in the claims and specification as described above, the rejection of claims 1-18 under 35 USC 112, second paragraph is maintained. In the interest of furthering prosecution, this Action will attempt to apply art to the claims as meaningfully as possible.

6. Applicant's arguments filed May 30, 2007 regarding the rejections under 35 USC 102 and 103 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:



(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 4-8, 13, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katsuji (Japanese Publication No. 11-164121) in view of Postel ("RFC 821: Simple Mail Transfer Protocol").

9. Regarding claim 1, Katsuji shows an apparatus comprising:

- a. means transmitting an electronic mail via a mail server (LAN I/F 16);
- b. means for storing information representing a plurality of mail servers and a priority order of the respective mail servers (memory section 17: see [0017]);
- c. selection means (system control section 11) for selecting a mail server for transmitting an electronic mail in accordance with the priority order stored in the means for storing (see [0017]); and
- d. determining means (system control section 11) for determining a type of failure that has occurred when the transmission of the electronic mail via the selected mail server fails (comprising determining that SMTP server 20 has stopped for failure or maintenance: see [0017]), and for determining, in accordance with the type of failure determined, whether to select a mail server of next in priority order (comprising determining to select the next mail server upon detecting a failure of the first server: see [0017]-[0022]).

10. Katsuji does not show a determining means for determining whether to establish a connection again with the mail server that was selected at the time of the failure in the transmission of the electronic mail, or to cancel the transmission.

11. Postel shows a determining means for determining whether to establish a connection again with the mail server that was selected at the time of the failure in the transmission of the electronic mail (comprising the logic which performs the functionality described in the discussion of "Transient Negative Completion" errors on pp. 48-49), or to cancel the transmission (comprising the logic which performs the functionality described in the discussion of "Permanent Negative Completion" errors on p. 49).

12. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Katsuji with the determining means taught by Postel in order to accommodate three most likely email failure conditions: (1) the failure of a mail server, as taught by Katsuji; (2) temporary errors which are likely to be resolved prior to a second request, as taught by Postel; and (3) permanent errors which are *not* likely to be resolved prior to a second request, as taught by Postel.

13. Regarding claim 4, the combination of Katsuji and Postel shows the limitations of claim 1 as applied above, and Katsuji further shows wherein the determining means determines that the type of failure is a failure in a connection with the selected mail server, a mail server of the next in priority order is selected (see [0020]).

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14. Regarding claim 5, the combination of Katsuji and Postel shows the limitations of claim 4 as applied above, but does not show wherein when the determining means determines the failure in the connection with the selected mail server, the mail server of the next in order is selected immediately without waiting for an elapse of waiting time.

15. However, the Examiner takes Official Notice that it is notoriously old and well-known in the art to fail over immediately to a redundant resource without waiting for an elapse of waiting time. It would have been obvious to one of ordinary skill in the art to modify the invention of Katsuji by selecting the next server immediately in order to prevent excessive delays caused by multiple inaccessible servers.

16. Regarding claim 6, the combination of Katsuji and Postel shows the limitations of claim 1 as applied above, but does not show wherein when a connection with the selected mail server is established the determining means determines that the type of failure is temporary error generated during a communication, the connection is established again with the mail server that was selected at the time of the failure in the transmission of the electronic mail.

17. Postal shows wherein a communication with a mail server is established and a temporary error is generated, the connection is established again with a mail server that was selected at the time of the failure in the transmission of the electronic mail (see discussion of "Transient Negative Completion" errors on pp. 48-49). It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the

combination of Katsuji and Postel in order to accommodate situations where the problem causing the error is likely to have been resolved between requests.

18. Regarding claim 7, the combination of Katsuji and Postel shows the limitations of claim 1 as applied above, but does not show wherein when the determining means determines that the type of failure is a failure in the transmission of the electronic mail due to incorrect destination, the transmission is cancelled.

19. Postal shows wherein when failing in the transmission of an electronic mail is due to incorrect destination, the transmission is cancelled. See discussion of "Permanent Negative Completion" errors on p. 49 and note that error code 550, which indicates that the destination mailbox is unavailable as described on p. 35, is a permanent error. It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the combination of Katsuji and Postel in order to accommodate situations where the problem causing the error is not likely to have been resolved between requests.

20. Regarding claim 8, the combination of Katsuji and Postel shows the limitations of claim 7 as applied above, and further shows wherein the determining means determines the failure in transmission of the electronic mail due to the incorrect destination, the transmission is cancelled (see above), but does not show that a message indicating such a fact is output.

21. Postal shows wherein a message indicating such a fact is output (comprising returning a 550 Failure reply: see the last paragraph of p. 4). It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the combination of Katsuji and Postel with the message output of Postel in order to alert users that a permanent error has occurred.

22. Regarding claim 13, the combination of Katsuji and Postel shows the limitations of claim 1 as applied above, and further shows a mail server list which stores the plurality of mail servers and the priority order of the plurality of mail servers (see [0017]), but does not show wherein the mail server list is rewritable.

23. However, the Examiner takes Official Notice that it is notoriously old and well-known in the art to make a data structure rewritable. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Katsuji by making the mail server list rewritable in order to allow a user to alter it in the future.

24. Regarding claim 19, the limitations thereof correspond to those of claim 1, and the claim is therefore rejected for the reasons given above.

25. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katsuji (Japanese Publication No. 11-164121) in view of Postel ("RFC 821: Simple Mail Transfer Protocol"), and further in view of Glasser et al. (US Pat. No. 5,956,715, hereinafter "Glasser").

26. Regarding claim 9, the combination of Katsuji and Postel show the limitations of claim 1, but does not show:

- e. a plurality of means for transmitting,
- f. a plurality of destinations of the electronic mail, and
- g. means for storing whether or not to select a mail server of next in priority order for each means for transmitting or for each destination of the electronic mail.

27. Postel shows a plurality of destinations for the electronic mail (see p. 6). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combination of Katsuji and Postel with the multiple destinations taught by Postel in order to provide for the ability to send to multiple email recipients.

28. Glasser shows a plurality of "means for transmitting" (comprising users) and a means for storing (comprising an "access control list": see col. 4, lines 60-64) which stores whether the particular users have permission to use "many different kinds of resources" on a network (see col. 10, lines 63-65). It is noted that there are insubstantial differences between the access control list of Glasser and the permission table described in applicant's specification. Both are lists that associate users with the permissions of those users to access network resources (see Glasser, col. 1, lines 54-58).

29. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combination of Katsuji and Postel with the permission table of

Glasser in order to prevent a user from having unlimited access to all server resources (see Glasser, col. 1, lines 45-47).

30. Regarding claim 10, the combination of Katsuji, Postel, and Glasser shows the limitations of claim 9 as applied above, and note that the bypass permission table which stores whether or not to select a mail server of next in order for each means for transmitting or for each destination (comprising the permission table as described above) can be formed and rewritten (see Glasser, col. 8, line 55 to col. 9, line 3).

31. Regarding claim 11, the combination of Katsuji, Postel, and Glasser shows the limitations of claim 1 as applied above, but does not show wherein there is a limit on whether or not to select a mail server of next in priority order according to a level of authority of a means for transmitting.

32. Glasser shows limiting access to network resources according to a level of authority of a user (see col. 1, lines 54-58). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Katsuji with the authority system of Glasser in order to prevent a user from having unlimited access to all server resources (see Glasser, col. 1, lines 45-47).

33. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Katsuji (Japanese Publication No. 11-164121) in view of Postel ("RFC 821: Simple Mail Transfer Protocol"), and further in view of Shimano (US Pat. No. 4,835,730).

34. The combination of Katsuji and Postel shows the limitations of claim 1 as applied above, but does not show wherein a transmitter can determine whether or not to select the mail server of next in order for each transmission of an electronic mail.

35. Shimano shows a user determining whether to skip a current operation and move onto another (see col. 53, lines 34-42). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Katsuji in view of Postel with the error recovery decision making of Shimano in order to allow a human user to influence the behavior of the system.

36. Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katsuji (Japanese Publication No. 11-164121) in view of Postel ("RFC 821: Simple Mail Transfer Protocol"), and further in view of Witek (US Pat. No. 5,461,488).

37. Regarding claim 14, the combination of Katsuji and Postel shows the limitations of claim 1 as applied above, but does not show a means for forming a transmission log; wherein "transmission date and time," "destination," "mail server that was used," and "transmission result" are written in the transmission log.

38. Witek shows a means for forming a transmission log (control code 22) which logs a variety of information (see col. 4, lines 32-56). It would have been obvious to modify the combination of Katsuji and Postel with the logging taught by Witek in order to store event information for subsequent reference and future use (see Witek, col. 4, lines 35-36).

39. Regarding claim 15, the combination of Katsuji and Postel in view of Witek shows the limitations of claim 14 as applied above, but does not show wherein the transmission log is formed for each Transmission Control Protocol (TCP) connection.

40. Witek shows logging a variety of information (see col. 4, lines 32-56). It would have been obvious to modify the invention of Katsuji with the logging taught by Witek in order to store event information for subsequent reference and future use (see Witek, col. 4, lines 35-36).

41. Regarding claim 16, the combination of Katsuji and Postel in view of Witek shows the limitations of claim 14 as applied above, but does not show wherein the transmission log is formed for each Simple Mail Transfer Protocol (SMTP) connection.

42. Witek shows logging a variety of information (see col. 4, lines 32-56). It would have been obvious to modify the invention of Katsuji with the logging taught by Witek in order to store event information for subsequent reference and future use (see Witek, col. 4, lines 35-36).

Conclusion

43. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher D. Biagini whose telephone number is (571) 272-9743. The examiner can normally be reached on M-R 7:30-5, 7:30-4 alternate Fridays.

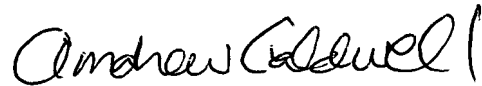
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Christopher D. Biagini
(571) 272-9743

July 16, 2007

A handwritten signature in black ink, appearing to read "Andrew Caldwell", with a stylized flourish at the end.

ANDREW CALDWELL
SUPERVISORY PATENT EXAMINER